

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 03226/503001; P8951	
		Application Number 10/627,019-Conf. #3673	Filed July 25, 2003
		First Named Inventor Bhavna Bhatnagar et al.	
		Art Unit 2432	Examiner B. E. Lanier
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,479</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;"> <p>_____ /Robert P. Lord/ Signature</p> <p>_____ Robert P. Lord Typed or printed name</p> <p>_____ (713) 228-8600 Telephone number</p> <p>_____ July 13, 2009 Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Bhavna Bhatnagar et al.

Confirmation No.: 3673

Application No.: 10/627,019

Art Unit: 2432

Filed: July 25, 2003

Examiner: B. E. Lanier

For: METHOD AND SYSTEM FOR PROVIDING A
CIRCLE OF TRUST ON A NETWORK

PRE-APPEAL BRIEF AND REQUEST FOR REVIEW

Authority

Applicants' claims have been rejected at least twice, so filing a Notice of Appeal with proper fee and a pre-appeal brief for review is proper. *See* 35 U.S.C. § 134.

Disposition of Claims

Claims 37-49 are pending. Claims 37, 41, and 45 are independent. The remaining claims depend, directly or indirectly, from the independent claims. The claims were finally rejected in the Office Action dated April 13, 2009 ("Final OA").

Rejection under 35 U.S.C. § 102

Claims 37-49 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent Publication No. 2004/0128392 ("Blakley"). "A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)) (emphasis added). Further, "[t]he identical invention must be shown in as

complete detail as is contained in the claim.” MPEP § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)).

The claims are directed toward granting access to a resource. Specifically, Applicants have enumerated and described the limitations recited by independent claim 37 on pages 2 – 3 of the Response to Office Action filed on February 18, 2009. Further, Applicants have also provided an Annotated Figure 7 with the aforementioned Response to aid in the understanding of limitations recited by claim 37.

Turning to the rejection, the analysis presented by the Examiner in the Final OA shows that the Examiner found no differences between the cited prior art and the claims. At the outset, the Applicants reiterate all arguments presented in the Response to Office Action filed on February 18, 2009. Further, Applicants respectfully assert that the Examiner has not made a proper finding that the cited prior art includes every element of the claims, and thus, has not factually supported a conclusion of anticipation for the claims under *Verdegaal Bros.* Moreover, because features in the prior art Blakley relied upon by the Examiner are not equivalent to the recited limitations of the pending claims, the Examiner has also failed to meet the standard set forth under *Richardson*.

I. The Examiner Has Misconstrued the Term “Trusted Partner List”

In issuing the rejection, the Examiner relies upon a user registry for verifying credentials of requesting users to disclose the limitation of a *trusted partner list* (i.e., operative in limitations (v) and (vi) as enumerated in Applicant’s Response of February 18, 2009). See page 4 of the Final OA (citing Blakley: Figure 5 and paragraphs [0171] – [0172]). Specifically, the Examiner maintains that a user registry qualifies as a trusted partner list according to a “broad but reasonable

interpretation of the claims.” See pages 2-3 of the Final OA (specifically, Examiner’s Response to Arguments #4). By definition, the user registry disclosed by Blakley is configured to store “information that is needed to authenticate a registered user.” See Blakley: paragraph [0094]. Information needed to authenticate a registered user includes, for example, “a username/password combination, a secret word, a hardware token such as a smartcard, a biometric identifier, etc.” See Blakley: paragraph [0170]. Accordingly, the user registry disclosed by Blakley *at best* stores user authentication information for a requesting user.

In view of the Examiner’s reliance upon Blakley’s user registry in making the rejection, Applicants respectfully assert that the Examiner has misconstrued the term “trusted partner list” as recited by the pending claims. In equating the user registry with a trusted partner list through “a broad but reasonable interpretation of the claims”, the Examiner has disregarded the requirements set out by *Phillips* to determine meaning of a claim term. Specifically, *Phillips* requires the Examiner to read the claimed limitations in light of the Specification. In particular, “[t]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but *in the context of the entire patent, including the specification.*” See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) (emphasis added). Based on *Phillips* and as clearly described in the Specification, “the trusted partner list for each entity will contain a record, *comprising the certificate, for each entity on the network that is affiliated with the particular entity.*” See paragraph [0029] of the Specification; Figure 4. Accordingly, because “each entity on the network that is affiliated” is effectively a server belonging to a circle of trust, the trusted partner list essentially includes certificates of all trusted servers. See Figures 4, 5, and 7; paragraphs [0034] – [0035] of the Specification. Contrary to

Phillips, the aforementioned definition of a trusted partner list was not used by the Examiner as evidenced by the Examiner's rejection of the pending claims.

As described above, entries in the user registry disclosed by Blakley include content for a requesting user. Because a trusted partner list includes certificates for servers and not users, the user registry cannot be properly construed as a trusted partner list under the requirements set forth by *Phillips*. Accordingly, because the user registry is not equivalent to a trusted partner list, Blakley cannot be said to disclose limitations (v) and (vi) of the pending claims as enumerated in Applicant's Response of February 18, 2009.

2. The Examiner Has Mischaracterized the User Credential of Blakley as a Certificate Associated with a Server

In issuing the rejection, the Examiner relies upon a requesting user's credentials to disclose the limitation of *a certificate associated with a server (i.e., operative in limitation (iv) as enumerated in Applicant's Response of February 18, 2009)*. See page 3 of the Final OA (citing Blakley: Figure 5 and paragraphs [0070], [0170], and [0171]). Specifically, the requesting user's credentials, as disclosed by Blakley, may comprise "anything that should only be possessed by the user, such as knowledge about a username/password combination, a secret word, a hardware token such as a smartcard, a biometric identifier, etc." See Blakley: paragraph [0170].

In view of the Examiner's reliance upon Blakley's user credentials in making the rejection, Applicants respectfully assert that the user credentials are merely associated with a requesting user and not a server entity as required by the pending claims. While Blakley provides abundant detail as to the variety of ways how (*i.e., login & password, secret word, token, biometric identifier, etc.*)

the user credential is tied to a specific requesting user, Blakley is completely silent as to any association between the user credential and a server entity. As such, Applicants respectfully assert that the cited-to user credential disclosed by Blakley is at best *only* associated with the requesting user and therefore cannot be properly construed as a certificate associated with a server entity as required by the pending claims. As such, Blakley does not disclose limitation (iv) of the pending claims as enumerated in Applicant's Response of February 18, 2009.

Conclusion

In view of the above, the Examiner has failed to satisfy the requirements of MPEP § 2131. Specifically, the cited prior art Blakley fails to disclose all of the limitations of pending independent claims 37, 41, and 45. Pending dependent claims are patentable for at least the same reasons. Accordingly, a favorable decision from the panel is respectfully requested. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03226/503001).

Dated: July 13, 2009

Respectfully submitted,

By /Robert P. Lord/
Robert P. Lord
Registration No.: 46,479
OSHA · LIANG LLP
909 Fannin Street, Suite 3500
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicants